

## UNITED STATES CEPARTMENT OF COMMERCE **United States Patent and Trademark Office**

COMMISSIONER OF PATENTS AND TRADEMARKS Washington, D.C. 20231

ATTORNEY DOCKET NO. FIRST NAMED INVENTOR FILING DATE APPLICATION NO. 2623-B TROUTT 01/20/00 09/488,728 **EXAMINER** HM22/0529 022932 JIANG. D IMMUNEX CORPORATION PAPER NUMBER ART UNIT LAW DEPARTMENT 51 UNIVERSITY STREET 6 1646 SEATTLE WA 98101 DATE MAILED: 05/29/01

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks** 

Application No.  09/488,728  TROUTT, ANTHONY B  Examiner  Dong Jiang  Art Unit  Dong Jia	<u></u>		_	Applicant(s)	
Office Action Summary  Examiner  Dong Jiang  Art Unit  1646  Period for Reply  A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM  THE MALLING DATE OF THIS COMMUNICATION.  The proof of reply a period because the provisions of 37 CFR 1.756 (a). In no event, however, may a reply be timely filed and the proof of reply appended above is less than the membrane period with the statutory minimum of thirty (30) days will be considered densely.  If the period for reply appended above is less than the membrane period will apply and will expire SK (b) MONTH5 from the mailing date of the communication.  If the period for reply appended above is less than the membrane period will apply and will expire SK (b) MONTHS from the mailing date of the communication of treply apply and will be considered densely.  If the period for reply appended above is less than the membrane period will apply and will expire SK (b) MONTHS from the mailing date of the communication of treply apply and will be considered densely.  If the period for reply apply and the date is the mailing date of this communication to the period of the communication.  Any reply section by the Office later than three months after the mailing date of this communication.  This action is FINAL.  2b) This action is non-final.  2a) This action is FINAL.  2b) This action is non-final.  Disposition of Claims  4) Claim(s) 2-6 is/are pending in the application.  4a) Of the above claim(s) is are withdrawn from consideration.  Claim(s) 1-1-4-4-5 (a) 1-1-4-5 (a) 1		Application No.			
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3) Since this application is in condition for allowance except for formal matters, prosecution as to the memors of closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.  Disposition of Claims  4) Claim(s) 3-6 is/are pending in the application.  4a) Of the above claim(s) is/are withdrawn from consideration.  5) Claim(s) is/are allowed.  6) Claim(s) is/are rejected.  7) Claim(s) is/are objected to.  8) Claims 3-6 are subject to restriction and/or election requirement.  Application Papers  9) The specification is objected to by the Examiner.  10) The drawing(s) filed on is/are objected to by the Examiner.  11) The proposed drawing correction filed on is: a) approved b) disapproved.  12) The oath or declaration is objected to by the Examiner.  Priority under 35 U.S.C. § 119  13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  a) All b) Some * c) None of:  1. Certified copies of the priority documents have been received.  2. Certified copies of the priority documents have been received in Application No  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).	A SHORTENED STATUTORY PERIOD FOR REPL THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1. after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a rej If NO period for reply is specified above, the maximum statutory period Failure to reply within the set or extended period for reply will, by statu.  - Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).  Status  1) Responsive to communication(s) filed on	.136 (a). In no event, howev ply within the statutory minim d will apply and will expire SI tte, cause the application to b ing date of this communication	er, may a reply be to num of thirty (30) da X (6) MONTHS fron become ABANDON on, even if timely file alal.	imely filed ys will be considered ti n the mailing date of th ED (35 U.S.C. § 133). sd, may reduce any	
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<ul> <li>1. Certified copies of the priority documents have been received.</li> <li>2. Certified copies of the priority documents have been received in Application No</li> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> </ul>	None of:				
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14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).	application from the internation	a list of the certified	copies not rec	ceived.	
	14) Acknowledgement is made of a claim for	domestic priority un	der 35 U.S.C.	§ 119(e).	
Attachment(s) Attachment(s) PTO-413) Paper No(s)	Attachment(s)		_		Danas No/o\
Attachment(s)  18) Interview Summary (PTO-413) Paper No(s)  15) Notice of References Cited (PTO-892)  16) Notice of Draftsperson's Patent Drawing Review (PTO-948)  17) Information Disclosure Statement(s) (PTO-1449) Paper No(s)  20) Other:	15) Notice of References Cited (PTO-892)	948) 19)	) Notice of In	ummary (PTO-413) formal Patent Applic	Paper No(s) · cation (PTO-152)

Application/Control Number: 09/488,728

Art Unit: 1646

## **DETAILED ACTION**

## Election/Restrictions:

This application contains claims directed to the following patentably distinct species of the claimed invention: there are 5 various immunoregulatory molecules listed in claims 5 and 6, and they are a soluble Type I IL-1 receptor, a soluble Type II IL-1 receptor, an IL-1 receptor antagonist, a soluble TNF receptor, and a fusion protein comprising an IL-1 receptor and a TNF receptor. Each listed immunoregulatory molecule has a distinct structure and function from the others, and each requires a separate search of the prior art.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 3 and 4 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Application/Control Number: 09/488,728

Art Unit: 1646

## Advisory Information

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 703-305-1345. The examiner can normally be reached on Monday - Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for the organization where this application or proceeding is assigned is 703-308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

LORRAINE SPECTOR PRIMARY EXAMINER

DJ 5/17/01